

By



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,909	02/19/2002	Shu Lin	PU 020035	4798

7590 09/23/2005

JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
2 INDEPENDENCE WAY
P.O. BOX 5312
PRINCETON, NJ 08543-5312

EXAMINER

CHEVALIER, ROBERT

ART UNIT	PAPER NUMBER
----------	--------------

2616

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/078,909

Applicant(s)

LIN ET AL.

Examiner

Bob Chevalier

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-11, 21, 23-31, 34-39 of copending Application No. 10/197,233. Although the conflicting claims are not identical, and that the claimed language of the present Application is somewhat different from the language recited in the in the copending Application No. 10/197,233, claims 1, 3-11, 21, 23-31, 34-39, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that the claims 1, 3-11, 21, 23-31, 34-39 of the copending Application 10/197233 would be able to perform the functions of the claimed limitations of the present Application since the limitations recited in the claimed invention of the present Application are also recited in the copending Application 10/197233, claims 1, 3-11, 21, 23-31, 34-39, including the feature of the selectively repeating at least one of the original pictures to convert the video signal to a trick mode video signal and selectively

inserting at least one dummy predictive picture in the trick mode video signal and the remote decoder arrangement recited in the claimed invention. Applicant's attention is directed to the copending Application 10/197,233, claims 1, 3-11, 21, 23-31, 34-39.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-5, 17-21, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-18, 33-37 of copending Application No.10/493,347. Although the conflicting claims are not identical, and that the claimed language of the present Application is somewhat different from the language recited in the in the copending Application No. 10/493347, claims 14-18, 33-37, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that the claims 14-18, 33-37 of the copending Application 10/493347 would be able to perform the functions of the claimed limitations of the present Application since the limitations recited in the claimed invention of the present Application are also recited in the copending Application 10/493347, claims 14-18, 33-37, including the feature of the selectively repeating at least one of the original pictures to convert the video signal to a trick mode video signal and selectively inserting at least one dummy predictive picture in the trick mode video signal.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-3, 11, 17-19, 25, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 19-21, 1, 40-42, and 35, respectively of copending Application No. 10/164874. Although the conflicting claims are not identical; and that the claimed language of the present Application is somewhat different from the language recited in the in the copending Application No. 10/164874, claims 19-21, 1, 40-42, and 35, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that the claims 19-21, 1, 40-42, and 35, of the copending Application 10/164874 would be able to perform the functions of the claimed limitations of the present Application since the limitations recited in the claimed invention of the present Application are also recited in the copending Application 10/164874, claims 19-21, 1, 40-42, and 35, including the feature of the selectively repeating at least one of the original pictures to convert the video signal to a trick mode video signal and selectively inserting at least one dummy predictive picture in the trick mode video signal.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-2, and 6-9, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, 9-11, respectively of copending Application No. 10/205192. Although the conflicting claims are not identical, and that the claimed language of the present Application is somewhat different from the language recited in the in the copending Application No.

Art Unit: 2616

10/205,192, claims 1, 7, 9-11, however, they are not patentably distinct from each other because it is noted that it would have been obvious to one of ordinary skill in the art to recognize that the claims 1, 7, 9-11, of the copending Application 10/205192 would be able to perform the functions of the claimed limitations of the present Application since the limitations recited in the claimed invention of the present Application are also recited in the copending Application 10/205,192, claims 1, 7, 9-11, including the feature of the selectively repeating at least one of the original pictures to convert the video signal to a trick mode video signal and selectively inserting at least one dummy predictive picture in the trick mode video signal.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-4, 6-9, 11-13, 15-17, 19-20, 22-25, 27-29, 31-32, are rejected under 35 U.S.C. 102(e) as being anticipated by Mercier.

Mercier discloses a video reproduction apparatus that shows all the limitations recited in claims 1, 11, including the feature of repeating at least one of the original

pictures to convert the video signal into a trick mode video signal (See Mercier's column 10, lines 25-28), and the feature of inserting at least one dummy predictive picture in the trick mode video signal as specified in the present claims 1, 11. (See Mercier's Figure 13).

With regard to claims 3, 12, 19, 28, modifying the display indicator of at least a portion of the plurality of original pictures to reflect an intended display order when an original picture is repeated or when a dummy bi-directional predictive picture is inserted in the trick mode video signal as specified thereof would be present in the cited reference of Mercier. (See Mercier's column 10, lines 36-38).

With regard to claims 4, 13, 20, 29, the feature of the display indicator being a temporal reference field as specified thereof would be present in the cited reference of Mercier. (See Mercier's column 10, lines 22-25, where it is disclosed the capability of adjusting the headers of the picture frames, like the temporal reference fields of picture headers).

With regard to claims 6, 22, the feature of the dummy predictive picture being predicted from a reference picture as specified thereof would be present in the cited reference of Mercier. (See Mercier's column 10, lines 16-28).

With regard to claims 7, 23, the feature of the reference picture being an intra picture as specified thereof is present in the cited reference of Mercier. (See the I frame shown in Mercier's column 10, lines 10-12).

With regard to claims 8, 24, the feature of the reference picture being a predictive picture as specified thereof would be present in the cited reference of Mercier. (See Mercier's column 10, lines 16-20).

With regard to claims 9, 15, 25, 31, the feature of the portion of the trick mode video signal being decoded by a remote decoder as specified thereof is present in the cited reference Mercier. (See Mercier's Figure 2, component 224, and Figure 15, component 1542, and column 5, lines 6).

With regard to claims 16, and 32, the feature of the encoded signal containing at least dummy predictive picture, and additional pictures selected from the group comprising intra pictures, predictive pictures, or bi-directional predictive pictures as specified thereof would be present in the cited reference of Mercier. (See Mercier's column 10, lines 4-22).

With regard to claims 17, 27, the feature of reading data from a storage medium and generating the video signal containing the plurality of original pictures as specified thereof is present in the cited reference of Mercier. (See Mercier's Figure 2, components 200, and 212, and Mercier's Figure 15, components 1500, and 1510).

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 571-272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

Art Unit: 2616

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ROBERT CHEVALIER
PRIMARY EXAMINER

B. Chevalier
September 17, 2005.